

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 09/986,554
Attorney Docket No. Q67202

REMARKS

Upon entry of the present Amendment, claims 5-10 and 15-20 are all the claims pending in the application. Claims 5, 8, 15 and 18 are amended. No new matter is presented.

Initially, Applicant thanks the Examiner for considering the references submitted with the Information Disclosure Statement of September 14, 2004 and for returning the initialed copy of the Form SB/08.

Claim Rejections - 35 U.S.C. § 103

Claims 2-10 and 12-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Woolston (U.S. Patent No. 5,845,265 in view of Walker (U.S. Patent No. 6,108,639) and Ghosh, "Tricks and Clicks with Bricks", Forbes, August 21, 2000, p. 116 (hereinafter "Ghosh"). The outstanding rejections are traversed, as discussed below.

Independent Claims 2 and 12

Applicant submits that the rejection of claims 2 and 12, as well as dependent claims 3-4 and 13-14, is moot in view of their cancellation without prejudice or disclaimer.

Independent Claims 5 and 15

Applicant respectfully submits that the combination of Woolston, Walker, and Ghosh, even assuming *arguendo* that the Examiner's asserted motivation to combine these teachings is proper, would not have rendered claims 5 and 15 *prima facie* obvious because the references fail

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to teach all the limitations of the claims as presently recited. For instance, claim 5 defines an ordering method comprising, *inter alia*, transmitting sales information from an agent server to a user terminal via a communication network, wherein the sales information includes product listings for a plurality of items which are sold only at sales shops that are not accessible via the communications network.

Claim 5 further recites the features of displaying, at the user terminal, the transmitted sales information, wherein the user terminal transmits a first search request signal to the server to request a service charge associated with *performing a search by an agent at specified sales shops*, which are selected by the user, among the sales shops that are *not accessible via the communications network* for a desired item if the desired item is not included among the plurality of items included in the product listings and the service charge associated with performing the search is requested by the user. In addition, claim 5 recites transmitting, from the agent server, a search report which includes results of the search for the desired item performed by the agent at the specified sales shops that are not accessible via the communications network to the user terminal, and displaying the transmitted search report, wherein the user terminal transmits a purchase order of the desired item to be purchased by the agent *if the search report indicates that the desired item is available for purchase* from at least one of the specified sales shops that are not accessible via the communications network and purchase of the desired item is instructed by the user.

Applicant respectfully submits that Woolston fails to teach *at least* the feature of requesting a service charge associated with performing a search by an agent at specified sales

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shops, as defined by claim 5, which are among the sales shops that are not accessible via the communications network for the desired item. In this regard, Applicant notes that Woolston teaches a network of consignment nodes in which a consignment node operator located at a used goods or collectible shop posts information on goods that have been presented to the shop owner, who acts as a bailee of the good for the purpose of an auction that is subsequently conducted via the network of consignment nodes. *See* Woolston at col. 2, lines 20- 51 and col. 6, lines 10-44. As taught by Woolston, bids for the item being auctioned are accepted either from other consignment nodes (i.e., terminals at other shops connected to the network) or from user PC's located at a participant's home, which would also be connected to the consignment node network. *See* Woolston at col. 2, lines 51-67 and col. 6, lines 10-14.

Further, although Woolston teaches an "Agent Mode", the searching by Woolston's agent is merely conducted of "other consignment nodes", which are necessarily *connected to the consignment node network* and, hence, designate shops that are *accessible* by the network, for requested goods. *See* Woolston at col. 7, lines 2-49. Consequently, Woolston fails to suggest requesting a service charge associated with performing a search by an agent at specified sales shops, which are selected by the user, among the sales shops that are *not accessible via the communications network* for a desired item, as the only searching in Woolston's consignment node network is limited to searching of shops that are necessarily accessible by the consignment node network. Indeed, Woolston further fails to suggest the claimed feature of transmitting the search report which includes results of the search for the desired item performed by the agent at

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the specified sales shops, as well as transmitting a purchase order, as claimed, if the search report indicates that the desired item is available for purchase.

Moreover, neither Walker nor Ghosh compensate for at least the above deficiencies of Woolston. For instance, Walker teaches a conditional purchase order (CPO) management system for the sale of collectible items (i.e., coins, stamps, art prints, comic books, etc.), in which a purchaser is allowed to conditionally purchase an item from an electronic sale via a network, and the item is then sent to an authenticator who examines the item to determine its authenticity.

See Walker at col. 5, lines 7-39. Then, if the authenticator determines that the item is valid, the sale is completed and the item shipped to the purchaser (i.e., the conditional purchase is made final). *See Walker at col. 12, line 59 - col. 13, line 7.* Conversely, if the authenticator determines the item to be invalid, the conditional purchase may be cancelled or further negotiations for reduced price may be conducted. *See Walker at col. 12, lines 35-58.* Further, Ghosh simply teaches purchasers of products offered for sale on an electronic network have "...the option of paying for a more detailed inspection..." of the products. *See Ghosh at p. 116 (next to last paragraph of page 2 of the copy provided by the Examiner).*

Therefore, as evidenced by the foregoing, even assuming for the sake of argument that the Examiner's asserted motivation to combine the teachings of Woolston, Walker, and Ghosh is proper, the combination would fail to teach all the features of claim 5. Additionally, Applicant submits that the above arguments are applicable to claim 15, which defines an apparatus which recites features analogous to those discussed above, and the features are likewise deficient in the applied references. Accordingly, reconsideration and withdrawal of the rejection of claims 5 and

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15 is requested. Further, Applicant submits that claims 6-7 and 16-17 are allowable at least by virtue of depending from claims 5 and 15, respectively, and by virtue of the features recited therein.

Claims 8 and 18

Independent claims 8 and 18 respectively define a method and apparatus reciting, *inter alia*, the features of requesting a second service charge required for performing a search by an agent at specified sales shops, which are selected by the user, among the sales shops that are not accessible via the communications network for a desired item which is not included in the displayed information, and transmitting a search report which includes results of the search for the desired item performed by the agent at the specified sales shops that are not accessible via the communications network to the user terminal.

Thus, for reasons analogous to those discussed above with respect to claims 5 and 15, Applicant submits that *at least* these features of claims 8 and 18 are not taught by the combination of Woolston, Walker, and Ghosh. Accordingly, claims 8 and 18 should likewise be allowable, and reconsideration and withdrawal of the rejection is respectfully requested. Further, Applicant submits that claims 9-10 and 19-20 are allowable at least by virtue of their dependency and by virtue of the features recited therein.

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Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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